

**REMARKS**

Applicants have amended their claims in order to further clarify the definition of various aspects of the present invention. Specifically, Applicants have incorporated the subject matter of claim 15 into each of claims 1 and 4; in light thereof, claim 15 has been cancelled without prejudice or disclaimer. Claims 1 and 4, as well as independent claim 6, have been amended to recite an adhesive film for bonding circuit members, the adhesive film adapted to be put between circuit electrodes facing each other. Claim 6 has been amended to incorporate therein the subject matter expressly set forth in claim 10; and, correspondingly, claim 10 has been cancelled without prejudice or disclaimer. The previously considered claims that remain in the application have been amended, consistent with amendments to the independent claims, to recite the adhesive "film" for bonding circuit members.

Applicants are adding new claims 33 and 34. Claim 33 recites an adhesive film for bonding circuit members, the adhesive film adapted to be put between circuit electrodes facing each other, with the adhesive film including a first adhesive layer including an adhesive resin composition and an insulative inorganic filler, this insulative inorganic filler being contained in a specified amount, and with the adhesive film further including conductive particles. Claim 34, dependent on claim 33, recites that the conductive particles have a larger average particle diameter than the average particle diameter of the insulative inorganic filler. In connection with claims 33 and 34, note, for example, previously considered claim 16.

Applicants respectfully traverse the rejection of their claims under the second paragraph of 35 USC §112, as set forth on page 2 of the Office Action mailed January 6, 2005, particularly insofar as this rejection is applicable to the claims as presently amended. It is respectfully submitted that the present claims are clear with respect to the subject matter thereof. That is, the claims recite an adhesive film,

adapted to be used in a specified manner, with the adhesive film comprising specific structure/properties. It is respectfully submitted that the present claims are sufficiently definite so as to satisfy the requirements of the second paragraph of 35 USC §112, with respect to an adhesive film being presently claimed.

Applicants respectfully submit that all the claims presented for consideration by the Examiner patentably distinguish over the teachings of the reference applied by the Examiner in rejecting claims in the Office Action mailed January 6, 2005, that is, the teachings of U.S. Patent No. 6,090,468 to Shimada, et al., under the provisions of 35 USC §102 and 35 USC §103.

Initially, note that U.S. Patent No. 6,090,468 to Shimada, et al. is assigned to the same Assignee as the Assignee of the above-identified application. **It is hereby stated by the undersigned that as of the date the invention of the above-identified application was made, the above-identified application and U.S. Patent No. 6,090,468 were owned by the same owner, that is, Hitachi Chemical Co., Ltd.** See Manual Of Patent Examining Procedure 706.02(I)(2)(II).

Noting that U.S. Patent No. 6,090,468 qualifies as prior art only under 35 USC §102(e), and that the above-identified application has a filing date of April 23, 2001, it is respectfully submitted that No. 6,090,468 is disqualified as prior art under 35 USC §103.

Furthermore, it is noted that the subject matter of claim 15 has been incorporated into each of claims 1 and 4; and that the subject matter of claim 10 has been incorporated into claim 6. In addition, claim 33 recites that the adhesive film includes conductive particles, previously recited in claims 15 and 16; and, moreover, claim 34 recites relative particle sizes of the conductive particles and of the insulative inorganic filler, consistent with previously considered claim 16. In light of recitations incorporated into claims 1, 4 and 6, and in light of claim 33, and noting claims which

were not rejected on prior art in the Office Action mailed January 6, 2005, it is respectfully submitted that all of the present claims should now be allowed.

In any event, note that U.S. Patent No. 6,090,468 to Shimada, et al., discloses a multi-layer wiring board for mounting a semiconductor device. The wiring board has a multi-bonding-deck cavity for housing a semiconductor device and includes at least two wiring boards having at least one wiring surface and a cavity, the two wiring boards being bonded to each other with an insulation adhesive layer, the insulation adhesive layer having an elastic modulus of 1,400 MPa or lower as measured at 25°C, having a coefficient of thermal expansion of 450 ppm/°C or lower in a direction of thickness and being a cured product of a semi-cured product of a specific adhesive composition. See column 2, lines 28-62. Note also column 3, lines 61-65, and column 4, lines 2-9; column 4, line 66 through column 5, line 4; and the paragraph bridging columns 5 and 6. This patent discloses that to control coefficient of thermal expansion and elastic modulus, the adhesive composition may further contain 9-57% by weight of inorganic fillers based on the total weight of the adhesive composition, various inorganic fillers being described. See column 7, lines 31-34 and 42-48. Note also Table 3 in columns 15-18, in each example disclosing an elastic modulus of at least 300 MPa.

It is emphasized that Shimada, et al., discloses, inter alia, an insulation adhesive layer. It is respectfully submitted that this reference does not disclose, nor would have suggested, an adhesive film adapted to be put between circuit electrodes facing each other, the circuit electrodes facing each other being pressed interposing the adhesive film between them, to interconnect the electrodes electrically in the direction of pressing, with the adhesive film including, inter alia, conductive particles; or other features of the present invention as in the present claims, including, inter alia, relative average particle diameters of the insulative

inorganic filler and conductive particles and/or amount of conductive particles in the adhesive film, and/or elastic modulus of the third adhesive layer where the adhesive film has a multi-layer construction.

The contention by the Examiner in the paragraph bridging pages 2 and 3 of the Office Action mailed January 6, 2005, is noted. The present claims are directed to an adhesive film, adapted to be used in a specific way. It is respectfully submitted that the "adapted to be" language must be considered in determining patentability. Moreover, it is again emphasized that Shimada, et al. discloses an insulative adhesive layer. Properly construing the present claims, as compared to the teachings of Shimada, et al., it is respectfully submitted that the teachings of the applied reference would have neither disclosed nor would have suggested an adhesive film "adapted to be" put between circuit electrodes facing each other, the circuit electrodes facing each other being pressed interposing the adhesive film between them, to interconnect the electrodes electrically in the direction of pressing, as in the present claims; and/or other features of the present invention as discussed previously, such as, inter alia, incorporating conductive particles.

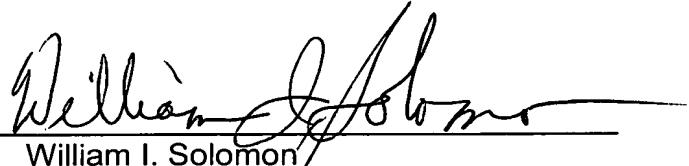
In view of the foregoing comments and amendments, reconsideration and allowance of all claims presently in the application are respectfully requested.

Applicants request any shortage of fees in connection with the filing of this paper be charged to the Deposit Account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (case 1303.39636X00), and any excess fees should be credited to such Deposit Account.

Respectfully submitted,

**ANTONELLI, TERRY, STOUT & KRAUS, LLP**

By

A handwritten signature in black ink, appearing to read "William I. Solomon", is written over a horizontal line.

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